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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,144	12/21/2000	Wayne E. Cornish	ACS58266(15951)	2421

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EXAMINER

FOREMAN, JONATHAN M

ART UNIT PAPER NUMBER

3736

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/746,144

Applicant(s)

CORNISH ET AL.

Examiner

Jonathan ML Foreman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7, 10 and 20-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7, 10 and 20-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 7, 10 and 22 - 26 rejected under 35 U.S.C. 102(b) as being anticipated by Yamauchi et al. ('159).

In regards to claims 7, 10 and 22 – 26, Yamauchi et al. ('159) discloses a superelastic member having a first section (2a) with a first set of properties and an adjacent second section (2) having a second set of properties which have been altered from the first set of properties by alloying the second section with an easily diffusible element selected from the group consisting of oxygen, hydrogen, carbon and nitrogen (Page 5, lines 1 – 3), wherein the superelastic member comprises a nickel-titanium alloy (See Abstract). The altered properties comprise reduced superelasticity. The second section comprises a distal end having a length at least about 3 cm.

3. Claims 7, 10 and 22 - 26 rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 6,325,766 to Anderson et al.

In regards to claims 7, 10 and 22 – 26, Anderson et al. discloses a superelastic member having a first section (14) with a first set of properties and an adjacent second section (12) having a second set of properties which have been altered from the first set of properties by alloying the second section with an easily diffusible element selected from the group consisting of oxygen,

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hydrogen, carbon and nitrogen (Col. 2, lines 14 – 17), wherein the superelastic member comprises a nickel-titanium alloy (Col. 2, lines 40 – 43). The altered properties comprise reduced superelasticity. The second section comprises a distal end having a length at least about 3 cm (Col. 2, line 63 – Col. 3, line 10).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 7, 10, 20, 21, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,325,766 to Anderson et al. in view of US Patent No. 5,722,981 to Stevens.

In regard to claims 7, 10, 20, 21, 23 and 24, Anderson et al. disclose an elongated medical device having a superelastic member (12) having a first set of properties and an adjacent second section (14) having a second set of properties. The second section includes a distal end that is at least about 3 cm in length. Anderson et al. discloses using any pseudo- or super-elastic alloys or shape memory nickel-titanium alloys (Col. 2, lines 38 – 43) for the second section, but fails to disclose the alloy including an easily diffusible element consisting of oxygen or hydrogen. However, Stevens teaches a nickel-titanium alloy which includes oxygen or hydrogen (Col. 3, lines 41 – 47). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the distal section as disclosed by Anderson et al. to include a nickel-titanium alloy which has been alloyed with an easily diffusible element as taught by Stevens et al. in order to allow the

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medical device to have a pre-formed shape, be stressed into another shape, and then return to its pre-formed shape.

Response to Arguments

6. Applicant's arguments filed 5/9/06 have been fully considered but they are not persuasive. Applicant asserts that Yamauchi et al. fails to disclose the base section and the apex section being made of different materials. However, the Examiner disagrees. The bottom of page 4 and the top of page 5 of the provided machine translation describe a portion of the device being formed with the nickel-titanium alloy including carbon, and a portion being made of nickel-titanium alloy.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

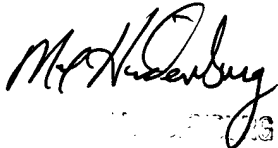
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (571)272-4724. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


JMLF


Max Hindenburg
Supervisor
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